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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-----------------------------------|---------------------|------------------|
| 09/471,276 | 12/21/1999 | Jean-Baptiste Dumas Milne Edwards | GENSET.025CP1 | 7217 |
| 23557 | 7590 | 12/04/2003 | EXAMINER | |
| SALIWANCHIK LLOYD & SALIWANCHIK A PROFESSIONAL ASSOCIATION 2421 N.W. 41ST STREET SUITE A-1 GAINESVILLE, FL 326066669 | | | ZHOU, SHUBO | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1631 | |

DATE MAILED: 12/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SM.

| | | | |
|------------------------|--------------------------------------|---------------------------------------|--|
| Advisory Action | Application No. 09/471,276 | Applicant(s) EDWARDS ET AL. | |
| | Examiner Shubo "Joe" Zhou | Art Unit 1631 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation


5c):

In regard to rejection of claims 25-30 under 35 USC 101, applicants argue that amino acids -16 to -1 are identified as "signal peptide" in the sequence listing for SEQ ID NO:831, and the specification indicates the signal peptide can be used to direct the extracellular secretion of any protein to which they are operably linked, etc. Thus, the specification teaches credible use of the claimed polypeptides. This is not found persuasive because the Sequence Listing indicates "signal" for SEQ ID NO:831. It does not indicate amino acids -16 to -1 is a signal peptide. Further the claims are drawn to polypeptides consisting or comprising amino acids -16 to -1, or a fragment thereof. The specification does not assert that such polypeptides, such as a polypeptide consisting or comprising a fragment, e.g. just one amino acid, of -16 to -1 of SEQ ID NO:831, can be used to direct extra cellular secretion of polypeptides.

The rejection of claims 25-30 under 35 USC 112, first paragraph is maintained for reasons set forth above. Applicants did not respond to the rejection in the response.

The rejection of claims 25-30 under 35 USC 112, second paragraph has been withdrawn in view of applicants' argument (pages 3-4).

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JOHN S. BRUSCA, PH.D
PRIMARY EXAMINER